REMARKS

The present application includes pending claims 1-40, all of which have been rejected. Claim 20 has been amended to correct a minor typographical error. The Applicants request reconsideration of the claim rejections in view of the following remarks:

Claims 1-3, 20-28, and 39-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,167,138 ("Shennib") in view of United States Patent No. 6,496,585 ("Margolis"). Claim 40 stands rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,231,521 ("Zoth") in view of Margolis. Claims 4-19, and 29-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shennib in view of Margolis and Zoth. The Applicants respectfully traverse these rejections at least for the reasons previously set forth during prosecution and the following:

I. Compact Prosecution

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

> It is essential that patent applicants obtain a prompt yet complete examination of their applications. **Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application**, even if one or more claims are found to be deficient with respect to some statutory requirement. **Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action.** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that the current claim rejections now reflect "all reasons and bases" for rejecting the claims, despite the fact that these rejections are different than those delineated in previous office actions.

II. The Combination Of Shennib And Margolis Does Not Render Claims Of The Present Application Unpatentable

Applicants first turn to the rejection of claims 1-3, 20-28, and 39-40 as being unpatentable over Shennib in view of Margolis. The Office Action concedes that "Shennib does not clearly teach pre-test and automatically starting a hearing test after the at least one condition is satisfied." *See* July 1, 2005 Office Action at page 3. In order to overcome these deficiencies, the Office Action cites Margolis at Figure 3 and column 4, line 61 to column 5, line 36.

A. The Combination Does Not Teach Or Suggest A Pre-Test To Determine Whether At Least One Condition Related To The Position Of The Testing Probe In The Ear Canal Is Satisfied

Margolis relates to a method of "automatically select[ing] test ear and test frequencies to produce a diagnostic audiogram." *See* Margolis at Abstract. Margolis discloses a system in which "[t]ransducers 18 and 22 are placed on or behind S's ear." *See id.* at column 3, line 57. The transducers are placed **on or behind** the ears, but not within the ear canal.

Claim 1 of the present application, however, recites "at least one condition related to the position of the testing probe **in the ear canal** [being] satisfied, and automatically starting a hearing test after the at least one condition [related to the position of the testing probe **in the ear canal**] is satisfied." Because the transducers of Margolis are positioned on or behind the ears, Margolis cannot pre-test, or even test, "at least one condition related to the position of the testing probe **in the ear canal**. Therefore it follows that Margolis also cannot automatically start a "hearing test after the at least one condition is satisfied." Further, as noted above, the Office Action concedes that Shennib does not teach or suggest a "pre-test" that determines "whether at least one condition related to the position of the testing probe **in the ear canal** is satisfied. Because neither Shennib, nor Margolis, teach or suggest a pre-test that determines whether at least one condition related to the position of the testing probe in the ear canal is satisfied, the combination of the two references, by definition, also cannot teach or suggest this limitation. Thus, at least for this reason, the Applicants respectfully submit that the combination of Shennib and Margolis does not render claims 1-19 unpatentable.

For similar reasons, Applicants respectfully submit that neither Shennib or Margolis teach or suggest "performing... at least one first test related to the position of the testing probe in the ear canal," such as recited in claim 20. Thus, at least for this reason, the combination of Shennib and Margolis does not render claims 20-39 unpatentable.

B. The Combination Does Not Teach Or Suggest Automatically Starting A Hearing Test After The At Least One Condition Is Satisifed

As noted, above, the Office Action also concedes that Shennib does not teach or suggest "automatically starting a hearing test after the at least one condition is satisfied." *See* July 1, 2005 Office Action at page 3. Margolis also does not teach or suggest this limitation.

Margolis relates to a system and method that "automatically selects test ear and test frequencies." *See* Margolis at Abstract. Selecting a test ear and/or a test frequency, however, is not "automatically starting a hear test," such as recited in claim 1.

The Examiner Office Action cites Margolis at column 4, line 61 to column 5, line 36 as support for "automatically testing." However, this passage relates to Figure 3, which "illustrates the logic for the selection of **test frequency** and **test ear** for air-conduction testing using the default stimulus test." Again, however, selecting test frequency and/or a test ear is not "automatically starting a hearing test."

Even if one were to assume that "the air-conduction testing" is a "test," there simply is no pre-test that occurs before the it. For example, Margolis states the following:

> The default initial test ear for air-conduction testing is the right ear. L at 1kHz is determined for the right ear and then for the left ear. The test ear for the subsequent stimuli is the ear with the better L at 1kHz. ... Interactive frequencies... are **automatically tested** when the difference between two adjacent octave frequencies exceeds D, where D is a predetermined value.

Margolis at column 4, line 61 to column 5, line 12 (emphasis added). However, such "automatic testing" is part of the same air-conduction testing. That is, if such air-conduction testing is considered "the test," there is no "pre-test" upon which the air-conduction testing may be automatically activated.

If, however, this air-conduction testing of Margolis is considered the pre-test, then subsequent testing is not "automatically started" after the pre-test. For example, Margolis states the following:

> **After air-conduction testing is completed, E is prompted to place the bone-conduction transducer behind the ear with the poorer L....**

Id. at column 5, line 13-15 (emphasis added). As clearly noted above, **after** the air-conduction testing is complete, an operator manually configures the components for subsequent testing. Thus, if the air-conduction testing is viewed as a "pre-test," instead of a "test," Margolis does not teach, nor suggest, "automatically starting a hearing test," such as recited in claim 1, after the air-conduction test.

To reiterate, Margolis discloses a system and method in which "test ear and test frequencies [are] automatically selected to produce a complete diagnostic audiogram." However, Margolis does not teach, nor suggest, "automatically starting a hearing test." Further, as noted above, the Office Action concedes that Shennib does not teach or suggest "automatically starting a hearing test after the at least one condition is satisfied." Therefore, the combination of these references cannot, by definition, teach this limitation either. At least for these reasons, the Applicants respectfully submit that the combination of Shennib and Margolis does not render claims 1-19 unpatentable.

For similar reasons, the Applicants respectfully submit that the combination of Shennib and Margolis does not teach or suggest "automatically starting a second hearing test after the at least one first test is passed," as recited in claim 20, or "automatically starting a hearing test after it is determined that the testing probe is properly position in the ear canal," as recited in claim 40. Thus, the combination does not render claims 20-40 unpatentable. The Applicants also respectfully submit that the combination does not teach or suggest "automatically repeating steps (a) and (b) if it is determined that the testing probe is not properly positioned in the ear canal," as recited in claim 40, at least for the reasons discussed above.

III. The Combination Of Zoth And Margolis Does Not Render Claim 40 Of The Present Application Unpatentable

The Office Action cites Figure 6 as support for "determining whether the testing probe is properly positioned in the ear canal." *See* July 1, 2005 Office Action at page 7. In particular, the Office Action relies on the plurality of "soft insert(s) 28." *See id.* Notably, the Office Action argues "(see fig. 6 by **selects** difference types soft ear insert (28) for testing probe)." *See id.*

Merely "selecting" a soft ear insert, however, is not "**determining** whether the testing probe **is properly positioned in the ear canal**," as recited in claim 40. Zoth merely discloses that the "tip of the probe is covered with a disposable soft ear insert." *See* Zoth at column 10, lines 60-61. Neither Zoth, nor Margolis, however, teach or suggest "determining whether the testing probe **is properly positioned in the ear canal**," as recited in claim 40. Thus, the combination of Zoth and Margolis does not render claim 40 unpatentable at least for this reason.

Because Zoth does not teach or suggest "determining whether the testing probe is properly positioned in the ear canal," Zoth also cannot teach "automatically starting a hearing test after it is determined that the testing probe is properly positioned in the earn canal." As discussed above, Margolis also does not teach this limitation. Thus, the combination of Zoth and Margolis does not render claim 40 unpatentable at least for this reason.

Additionally, the Office Action concedes that Zoth does not teach or suggest "automatically repeating steps (a) and (b) if it is determined that the testing probe is not properly positioned in the ear canal." *See* July 1, 2005 Office Action at page 7. As explained above, Margolis also does not teach or suggest this limitation. Thus, the combination of Zoth and Margolis does not render claim 40 unpatentable at least for this reason.

IV. The Combination Of Shennib, Margolis, And Zoth Does Not Render Claims 4-19, and 29-38 Unpatentable

The Applicants now turn to the rejection of claim 4-19, and 29-38 as being unpatentable over Shennib in view of Margolis and Zoth. The Applicants respectfully

submit that these references do not render claims 4-19, and 29-38 unpatentable at least for the reasons discussed above.

V. Conclusion

Based on at least the foregoing, the Applicants believe that claims 1-40 are in condition for allowance. If the Examiner disagrees or has any question regarding this submission, the Applicants request that the Examiner telephone the undersigned at (312) 775-8000. A Notice of Allowance is courteously solicited.

Respectfully submitted,

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By: _____
Joseph M. Butscher
Reg. No. 48,326

McAndrews, Held & Malloy, Ltd.
500 West Madison Street - Ste. 3400
Chicago, Illinois 60661
(312) 775-8000